

Attorney Docket # 5151-18PUS

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re National Phase PCT Application of

Erwin OSER et al.

Int'l. Appln. No.: PCT/DE2004/053650

Int'l. Filing Date: 22 December 2004

Serial No.: 10/583,936

Filed: June 22, 2006

For: An Apparatus and Method for Converting
Heat Energy to Mechanical EnergyMail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450I hereby certify that this correspondence is being
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sufficient postage as first class mail in an envelope
addressed to: Mail Stop PCT, Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450, on

November 29, 2007

(Date of Deposit)

Alfred W. Froebrich

Name of applicant, assignee or Registered Representative

Signature

November 29, 2007

Date of Signature

RENEWED PETITION UNDER 37 CFR §1.47(a)

S I R:

Petition

Applicants hereby petition for a one month extension of the original shortened statutory response period set in the Decision on Petition of September 28, 2007. A check in the amount of \$120 in payment of the government fee for a one-month extension of time is enclosed herewith so that the period for response is extended to December 28, 2007. Any additional fees or charges required at this time in connection with the present application may be charged to our Patent and

Trademark Office Deposit Account No. 03-2412.

12/04/2007 GFREY1 00000100 10583936

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Background Information

This renewed petition is filed in response to a Decision on Petition dated September 28, 2007.

A petition under 37 CFR 1.47(a) was filed with the PTO for the above-referenced application on July 9, 2007.

The PTO issued the Decision on September 28, 2007, which dismisses the petition, without prejudice.

As the Examiner correctly points out in the Decision, a petition under 37 CFR 1.47(a) must be accomplished by

- (1) the fee under 37 CFR 1.17(h),
- (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort,
- (3) a statement of the last known address of the missing inventor, and
- (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

In the Decision dated September 28, 2007, the Examiner explicitly acknowledges that requirements (1), (3) and (4) have been met. However, it is alleged that requirement (2) has not been met because Exhibit A for the supporting Declaration by co-inventor, Mr. Erwin Oser, does not explicitly identify the application numbers for which documents are attached.

Remarks

Petitioner respectfully submits that requirement (2) has been met.

The Examiner's attention is respectfully drawn to MPEP 409.03(d), which states, *inter alia*,

“Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made” (emphasis added).

In the present application, Mr. Erwin Oser's supporting Declaration constitutes the required statement of facts because in it, Erwin Oser specifically declares that the application papers were sent to the non-signing co-inventor and that Erwin Oser received the refusal of the non-signing co-inventor to sign the application papers.

In addition, the Examiner's attention is respectfully drawn to the fact that parallel petitions for co-pending Application Serial Nos. 10/583,925 and 10/589,409 have been granted.

The Renewed Petition

By this renewed petition, acceptance of the above-referenced application made by the co-inventor, Erwin Oser, on behalf of himself and Michael Rannow (hereafter also referred to as “non-signing co-inventor”), is respectfully requested. A supporting Declaration executed by Mr. Erwin Oser is enclosed herewith.

The non-signing inventor's last known address is c/o Vacutec GmbH (bzw. Nero Energy GmbH), Max-Planck-Str. 11, 53577 Neustadt (Wied)-Fernthal, Germany. As stated in the attached supporting Declaration, the attempt to obtain the non-signing co-inventor's signature included sending a letter by certified mail to this address with all of the application papers including:

- A copy of the International Application Publication No. WO 2005/061857 A1, based on International Application No. PCT/EP2004/053650,

- An English translation of the International Application No. PCT/EP2004/053650,
- A copy of the preliminary amendment concurrently filed with the English translation as the above-referenced U.S. national phase application, and
- A combined Declaration and Power of Attorney for signature by Michael Rannow.

The certified mail reached and was accepted by the non-signing co-inventor on November 3, 2006. Thus, it is clear that the non-signing co-inventor was presented with all of the application papers. In an e-mail dated November 6, 2006, the non-signing co-inventor expressed an unwillingness to cooperate in the matter of the above-referenced U.S. patent application. Furthermore, Mr. Erwin Oser has not yet received executed application papers from the non-signing co-inventor.


As described above and evidenced by the attached supporting Declaration, a *bona fide* attempt using diligent effort was made to obtain the signature of the non-signing co-inventor. Furthermore, the conduct of the non-signing co-inventor, as described in the attached supporting Declaration, clearly constitutes a refusal to sign the application papers.

No more petition fee is needed because the petition fee required under 37 CFR 1.17(g) was paid in the petition under 37 CFR 1.47(a) submitted on July 9, 2007. Any additional fees or charges required at this time in connection with the application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

In view of the above remarks and the attached supporting Declaration, granting of this renewed petition is respectfully requested.

Respectfully submitted,

COHEN PONTANI LIEBERMAN & PAVANE LLP

By: 
Alfred W. Froeblich
Reg. No. 38,887
551 Fifth Avenue
New York, New York 10176
(212) 687-2770

Dated: 29 November 2007

Attorney Docket # 5151-18PUS

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Erwin OSER et al.

Serial No.: 10/583,936

Filed: June 22, 2006

For: An Apparatus and Method for Converting Heat
Energy to Mechanical Energy

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION IN SUPPORT OF PETITION UNDER 37 C.F.R. §1.47(a)

I, Erwin Oser, declare as follows:

1. This declaration is submitted in support of U.S. Patent Application Serial Number 10/583,936, which is a national phase filing based on International Application No. PCT/EP2004/053650, and, specifically to evidence refusal by co-inventor Michael Rannow (hereafter also referred to as "non-signing co-inventor") to sign the application papers.

2. I am a co-inventor of the above-referenced U.S. patent application.

3. On November 2, 2006, I placed the following items for the above-referenced U.S. patent application into an envelope to be sent by certified mail addressed to the non-signing co-inventor's current address (c/o Vacutec GmbH (bzw. Nero Energy GmbH), Max-Planck-Str. 11, 53577 Neustadt (Wied)-Fornthal, Germany) and with a letter written and signed by me requesting that the non-signing co-inventor sign the application papers and return them to me by November 16, 2006:

- A copy of the International Application Publication No. WO 2005/061857 A1, based on International Application No. PCT/EP2004/053650,

- An English translation of the International Application No. PCT/EP2004/053650,

- A copy of the preliminary amendment concurrently filed with the English translation as the above-referenced U.S. national phase application, and

- A combined Declaration and Power of Attorney and an Assignment for signature by Michael Rannow.

4. Copies of my November 2, 2006 letter to the non-signing co-inventor and its English translation are attached hereto as Exhibit A.

5. I then had the certified mail envelope sent to the non-signing co-inventor.

6. The certified mail envelope reached and accepted by the non-signing co-inventor on November 3, 2006. Copies of a letter from the German Post Office providing a reproduction of the delivery evidence, which delivery evidence was signed by the intended recipient Michael Ramow, and an English translation of the letter from the German Post Office, are attached hereto as Exhibit B.

7. In an e-mail dated November 6, 2006 addressed to Hubert Hamm, which was also sent to me, the non-signing co-inventor expressed an unwillingness to cooperate in the matter of the above-referenced U.S. patent application. Copies of a printout of the e-mail and its English translation are attached hereto as Exhibit C.

8. So far I have not received executed application papers from the non-signing co-inventor and the above-referenced e-mail dated November 6, 2006 further indicates his permanent refusal to sign the documents.

9. In view of the above, a *bona fide* attempt was made to obtain the signature of the non-signing co-inventor. Furthermore, the conduct of the non-signing co-inventor clearly constitutes a refusal to sign the application papers. Accordingly, the petition to accept the application made by me, on behalf of myself and the non-signing co-inventor should be granted.

10. I declare that all statements made herein of my own knowledge are true; that all statements made herein on information and belief to be true; and further that

these statements were made with the knowledge that willful, false statements and the like are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this patent application and any patent resulting therefrom.

Date: 4th July 2007

By: Erwin Oser
Erwin Oser

Exhibit A

Translation of the Attachments 2a and 2b

Certified Mail / Advice of Delivery

Dipl.-Chem. M. Rannow
c/o Vacutec GmbH (bzw. Nero Energy GmbH)
Max-Planck-Str. 11

53577 Neustadt (Wied)-Fernthal

Cologne, November ²11, 2006
buero/ER_Rannow

3 Patent applications in the USA

here: Signing of the declaration / power of attorney forms

Hello Michael,

following a suggestion of Dr. Michalski, I get back to an issue already discussed in the past concerning the three patent applications in the USA.

For your information I forward you the documents of the three patent applications that have been filed or amended in the USA, requesting you to sign the forms in each case on the last page at "Signature of Inventor 202".

This measure is based on the fact that there is a special regulation for patent applications in the USA. According to this regulation, forms must be signed by all persons that are designated as inventors. To avoid problems for the ongoing applications, Dr. Michalski urgently asks you to sign.

In consideration of the current situation of the patents, that is to say the establishment of a Patent GmbH involving a transfer of the relevant patents to the GmbH, I refer to the detailed explanations in the discussion with Mr. Hubert Hamm and Mr. Rob Terberg. Those have explained you in detail, how your interests and rights have been and will be taken into consideration at the establishment of the Patent GmbH. With regard to this, the signing of the forwarded forms is also directly in your own (and your all, respectively) interest!

Against this background, Hubert and I affiliate to the urgent petition of Mr. Michalski to complete the documents for the ongoing application procedure, that had to be initiated also due to effective due dates, by signing the three forms.

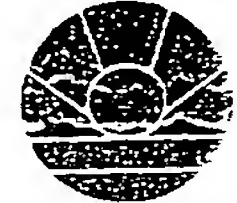
To not impede the proceeding of this issue, I ask you to sent back the signed forms or alternatively to give us your opinion on this until

Thursday, November 16, 2006

For possibly further explanations, the gentlemen involved in this issue Dr. Michalski and Hubert Hamm, and of course if wanted also I, are at your command.

Greetings,

Erwin Oser



EINSCHREIBEN / RÜCKSCHEIN

Dipl.-Chem. M. Rannow
c/o Vacutec GmbH (bzw. Nero Energy GmbH)
Max-Planck-Str. 11

53577 Neustadt (Wied)-Fernthal

Köln, 02.11.2006
buero/ER_Rannow

3 Patentanmeldungen in USA hier: Unterzeichnung der Declaration / Power of attorney Formulare

Hallo Michael,

auf Hinweis von Dr. Michalski komme ich zurück auf eine bereits früher behandelte
Angelegenheit, die die drei Patentanmeldungen in den USA betrifft.

Als Anlagen sende ich zu deiner Information und Kenntnisnahme die in den USA
eingereichten bzw. geänderten Unterlagen der drei Patentanmeldungen mit der Bitte, die
Formulare jeweils auf der letzten Seite bei „Signature of Inventor 202“ zu unterzeichnen.

Hintergrund für diese Maßnahme ist eine besondere Bestimmung für Patentanmeldungen in
den USA, nach der die Formulare von allen als Erfinder benannten Personen zu
unterzeichnen sind. Dr. Michalski bittet dringend zur Unterzeichnung, um Probleme für die
laufenden Anmeldungen zu vermeiden.

Hinsichtlich der aktuellen Situation zu den Patenten, d.h. die Einrichtung einer Patent GmbH
mit Übertragung der fraglichen Patente auf die GmbH verweise ich auf die ausführlichen
Erläuterungen in den Gesprächen mit Hubert Hamm und Herrn Rob Terberg. Diese haben
dir ausführlich dargelegt, wie deine Interessen und Rechte bei der Gründung der Patent
GmbH berücksichtigt wurden und werden. Im Hinblick darauf ist die Unterzeichnung der
übersandten Formulare unmittelbar auch in deinem (bzw. eurem) Interesse!

Vor diesem Hintergrund schließen Hubert und ich uns der dringenden Bitte von Herrn Dr.
Michalski an, die Unterlagen für das laufende Antragsverfahren, das auch wegen geltender
Ausschlussfristen eingeleitet werden musste, durch die Unterzeichnung der drei Formulare
zu vervollständigen.



Um den weiteren Fortgang der Angelegenheit nicht zu behindern, bitte ich um Rücksendung der unterschriebenen Formulare oder widrigenfalls um deine entsprechende Stellungnahme hierzu bis

Donnerstag, den 16. November 2006

Für etwaige weitere Erläuterungen stehen die in die Angelegenheit einbezogenen Herren Dr. Michalski und Hubert Hamm, auf Wunsch natürlich auch ich, zur Verfügung.

Herzliche Grüße

Erwin Oser

Exhibit B

Translation of the Attachments 3a and 3b

Firma

Dr. Oser / Partner in Technik

Hansaring 145-147

50670 Köln

Phone: 01805/290690

Date: November 15, 2006

Subject: Certified Mail Advice of Delivery

Dear sir or madam,

thank you for your query dated November 14, 2006. We are sorry that we could not please you with our service and that quality deficiencies occurred in conjunction with your letter.

As it is our ultimate ambition to please our clients with an as high as possible reliability, losing the advice of delivery is a deplorable incident, in particular for you as client, but also for us as service enterprise.

On this account, we sent you a reproduction of the delivery evidence as substitution for the lost advice of delivery. This is also a certificate for the delivery of the letter.

We assure you, that we will do everything to serve you in future once again reliable as usual. We apologize for the trouble caused and ask you for your comprehension.

Sincerely yours,

Your Customer Service

CERTIFIED MAIL and CASH on DELIVERY National

Attachment

Reproduction of the delivery evidence

Kundenservice
Einschreiben und Nachnahme National

Deutsche Post AG - Kundenservice Einschreiben und
Nachnahme National - Postfach 10 07 41 - 68007 Mannheim

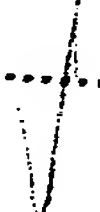
Deutsche Post 

BRIEF KOMMUNIKATION

Firma
Dr. Oser / Partner in Technik
Hansaring 145-147
50670 Köln

EINGEGANGEN

16. Nov. 2006

Erl.....


nr Zeichen

er Zeichen /

Telefon 01805/290690

Datum 15.11.2006

Betrifft EINSCHREIBEN RÜCKSCHEIN

Sendungsnummer: RR956711329DE

Sehr geehrte Damen und Herren,

vielen Dank für Ihre Anfrage vom 14.11.2006. Es tut uns leid, dass wir Sie mit unserem Service nicht zufrieden stellen konnten und es im Zusammenhang mit Ihrer Sendung zu Qualitätsmängeln gekommen ist.

Da es unser oberstes Ziel ist, unsere Kunden mit der größtmöglichen Zuverlässigkeit zufrieden zu stellen, ist der Verlust des Rückscheins ein bedauerliches Vorkommnis. Insbesondere für Sie als Kunden, aber auch für uns als Dienstleistungsunternehmen.

Aus diesem Grunde übersenden wir Ihnen stellvertretend für den verloren gegangenen Rückschein eine Reproduktion des Auslieferungsbeleges. Auch hierbei handelt es sich um eine Bestätigung der Zustellung der Sendung.

Wir versichern Ihnen, dass wir alles dafür tun werden, Sie auch in Zukunft wieder gewohnt zuverlässig zu bedienen. Für die entstandenen Unannehmlichkeiten entschuldigen wir uns und bitten um Ihr Verständnis.

Mit freundlichen Grüßen

Anlage

Reproduktion des Auslieferungsbeleges

Ihr Kundenservice
EINSCHREIBEN und NACHNAHME National

Dieses Schreiben wurde maschinell erstellt und trägt daher keine Unterschrift

Hausadresse
Wilhelm-Brandt-Platz
66161 Mannheim

Servicenummer
Telefon (01805) 290690
+12 Ct je angefangene Minute
im Festnetz
Mo-Fr 8-18 h

Vorstand
Dr. Klaus Zumwinkel, Vorsitzender
Dr. Frank Appel
John Mullen
Dr. Edgar Ernst
Dr. Peter Kruse
Dr. Hans-Dieter Petram
Walter Scheurle
Prof. Dr. Wulf von Schimmelmann

Vorsitzender
des Aufsichtsrates
Jürgen Weber

Sitz Bonn
Registergericht Bonn
HRB 6792

Auslieferungsbeleg

PLZ 53577 ZBez 02 ZAb



And Ausweisarten

Ausweis-Nr

Ausst. Behörde

☒ Empf ☐ EmpfBer ☐ Reisepass

☐ Brief ☐ And ☐ Personal-
EmpfBer ausweis

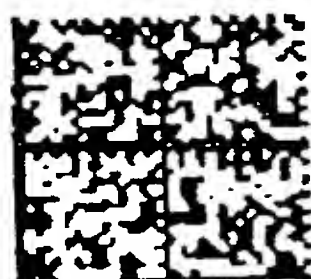
Ersatzempf gem. AGS BRIEF NATIONAL

Datum u. Unterschrift
Postmitarbeiter

03.11.06

Empfänger (u. g. Sendung(en)) dem Empfänger übergeben bzw. das/nie Einschreiben
des/der/dieser/dieser Internat. in die Empfangsvorrichtung des Empfängers ergiebt

RR956711329DE112



Empfangsbestätigung

Name u. Vorname
in Gross- u. Kleinstaben

Datum u. Unterschrift
Empfängerberechtigter

03.11.06

Ich bestätige, die o. g. Sendung(en) am heutigen Tag erhalten zu haben

Hubert C

Translation of Attachment 4

From: "Michael Rannow" <michael.rannow@vacutec.de>
To: <h.hamm@aqua-society.com>
Cc: "Holger Rannow" <rannow@smsprofi.de>; "Herr Dr. E. Oser - Dr. OSER/Partner in Technik" <dr.oser@dr-oser.de>; „U. Bottländer“ <u.bottlaender@aqua-society.com>
Sent: Monday, November 6, 2006, 14:15
Subject: Patents

Hello Hubert,

even if my messages apparently do not reach you, or you are able to afford not to react, I do not want to fail to keep you informed:

Your attempt to foist the US patents on me is very well received - from one hand I am enthused about how dumb you think I am, on the other hand I am fascinated of the presumptuousness that you exhibit. Unfortunately, after extensive consultation with various attorneys, I have to testify you that you are not half as clever as you think you are and your awesome line-up to oust me has unfortunately some flaws - that has the consequence that you, together with all your amazing strategists - which I however would amicably call wretched rats - will perish.

In the meantime, you will have received my protest against the patents - the proceeding versus Oser will take a couple of days - good things unfortunately need good preparation - but solace yourself, I have engaged good people - that will be something neat. Your next appearance at WDR is this time due to me - have fun with the AES

Micha

Frau Tramitz - Dr. OSER/Partner in Technik

Von: "Michael Rannow" <michael.rannow@vacutec.de>
An: <h.hamm@aqua-society.com>
Cc: "Holger Rannow" <rannow@smsprofi.de>; "Herr Dr. E. Oser - Dr. OSER/Partner in Technik" <dr.oser@dr-oser.de>; "U. Bottländer" <u.bottlaender@aqua-society.com>
Gesendet: Montag, 6. November 2006 14:15
Betreff: Patente

Hallo, Hubert,

auch wenn meine Nachrichten offensichtlich nicht bei Dir ankommen, oder Du es Dir leisten kannst, nicht darauf zu reagieren möchte ich nicht versäumen dich auf dem Laufenden zu halten:

Euer Versuch mir die US - Patente unterzujubeln ist sehr gut angekommen - zum einen bin ich begeistert für wie blöd Ihr mich haltet zum anderen bin ich fasziniert welche Dreistigkeit Ihr so an den Tag legt. Leider muß ich nach eingehender Beratung mit den diversen Anwälten Euch testieren, dass Ihr nicht halb so schlau seid für wie Ihr Euch haltet und Eure tolle Konstellation mich hier auszubooten leider einige Schönheitsfehler hat --was leider die Konsequenz hat, dass Du mit samt Deinen tollen Strategen - die ich unter Freunden allerdings als miese Ratten bezeichnen würde - untergehen wirst.

Mein Einspruch gegen die Patente wirst Du ja inzwischen erhalten haben - das Verfahren gegen Oser wird ja noch einige Tage dauern - gut Ding braucht leider Gute Vorbereitung - aber tröste dich, ich habe da gute Leute drangesetzt - das wir was ordentliches. Deinen nächsten Auftritt im WDR hast Du diesmal mir zu verdanken - viel Spass mit der AES

Micha